

Application No.: 10/772190

Case No.: 59529US002

REMARKS

Claims 7 to 20 are pending. Claims 1 to 6 have been withdrawn from consideration. Claims 7 and 20 have been amended to better clarify applicant's invention.

Support for the amendments can be found throughout the application. For example, in paragraph [0026], applicant stated "the layer 21 has a portion 40 removed therefrom to define an aperture therethrough which constitutes a paperless zone 42." (emphasis added). See also paragraph [0039] where applicant stated "[a] paper less zone 542 adjacent the upper edge 528 is illustrated by dashed lines 558 and defines an edge gay 544 across the upper edge 528."

Applicant appreciates the Examiner's indication that claim 20 contains allowable subject matter.

Claim Objections

Claim 7 was objected to based on an informality. Applicant has amended claim 7 as suggested by the Examiner.

§ 102 Rejections

Claims 7-11, 13, 15, 18 and 19 stand rejected under 35 USC § 102(b) as being anticipated by Chase (US 3,517,106).

In very brief summary, applicant's invention, as recited in amended claim 7, pertains to an index card assembly having a paper layer and a cover layer. The paper layer has a writable front side and an opposite back side. The paper layer has an upper edge with a paperless zone that includes a gap across the upper edge. The cover layer has an outer face and an inner face. The cover layer also has a pressure sensitive adhesive disposed on its inner face. The cover layer is adhered to the front side of the paper layer to cover the paperless zone in an alignment where a top edge of the cover layer extends across the gap of the paperless zone. The adhesive on the inner surface of the cover layer is exposed across the paperless zone on the back side of the paper layer.

As the Examiner noted, Chase '106 is directed to methods and materials for mounting pictures in accurate positions on mounting boards. In use, Chase discloses the following method:

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When a picture is to be secured to the mount of FIGS. 1 to 3, the mount preferably is placed on a horizontal surface such as a table top and the central release sheet section CR is removed from one side of the mount as in FIG. 1 and the picture P placed on the mount contacting only the remainder of the release sections IR, IR, ER, ER so that picture can be moved freely without contacting the exposed adhesive CA . . . . After the picture is accurately located and aligned in relation to the mount and guide lines G, the user presses his fingers F against the portion of the picture overlying the exposed adhesive CA and presses that portion of the picture into adhering contact with the adhesive A . . . . The release sections IR, IR and ER, ER are then progressively removed from the same side of the mount and the picture progressively pressed into contact with the adhesive, working from the center outwardly to the edges of the pictures. . . Column 5, lines 24-48.

Chase '106 does not anticipate applicant's invention for the following reasons. The Examiner equated the release liner in Chase to applicant's paper layer, as referenced on page 3 of the office action as "the paper release sheet". Applicant's invention recites a writeable front side. For discussion purposes, with reference to applicant's Figures 1-8, reference number 22 denotes the front side while 24 denotes the back side. The cover layer 50 has a pressure sensitive adhesive 56 disposed on its inner face 54. The cover layer 50 is adhered to the writable front side 22 of the paper layer 21 to cover the paperless zone 42 such that the adhesive 56 is exposed across the paperless zone 42 on the backside 24 of the paper layer. The Chase '106 invention is operable when the release liner covers substantially the entire adhesive A and the front side of the release liner is in direct contact with the adhesive. In such a case, it is not possible for the front side of Chase's release liner to be writable. Applicant respectfully disagrees with the Examiner's statement on page 4 that the "paper based release sheet [of Chase] inherently has a writable front side" because the front side is covered by the adhesive A. Once the user peels away a section of the release liner (e.g., center section CR), that section is no longer part of the construction of Chase's mount. Thus, even if the user were to now write on the first surface of the removed section CR, it is no longer part of the mount assembly.

Claims 8-11, 13, 15, and 18 depend from claim 7, each claim adding additional features to claim 7. Chase '106, for the reasons stated above, does not anticipate applicant's claim 7. Thus, claims 8-11, 13, 15, and 18 are likewise not anticipated by Chase '106.

The rejection of claims 7-11, 13, 15, and 18 under 35 USC § 102(b) as being anticipated by Chase '106 has been overcome and should be withdrawn.

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**§ 103 Rejections**

Claim 12 stands rejected under 35 USC § 103(a) as being unpatentable over Chase '106 in view of Nygard et al. (US 5,458,938).

Applicant's claim 12 depends from claim 7 and adds the feature that the adhesive is a repositionable pressure sensitive adhesive. Claim 7 is patentable over Chase for the reasons stated above.

The Examiner has cited Nygard '938 stating, on page 6 of the office action, the following:

Nygard teaches a mounting laminate to which documents . . . can be attached. . . [A] variety of known pressure sensitive adhesive can be used . . . and to permit mounted items to be removed without damage, the pressure sensitive adhesive should be repositionable. Thus, it would have been obvious . . . to chose the repositionable pressure sensitive adhesive in the invention of Chase, motivated by the desire to provide a reusable pressure sensitive adhesive mount to which a picture can be attached.

The combination Nygard's repositionable adhesive with Chase's mount would not lead one skilled in the art to applicant's invention because the combination does not cure the deficiency in Chase '106. That is to say, replacing the adhesive A of Chase with a repositionable adhesive of Nygard would achieve a combination where the front side of the paper release liner of Chase is still not writable because the repositionable adhesive covers the entire surface area of the paper release liner.

Claims 14, 16, and 17 stand rejected under 35 USC § 103(a) as being unpatentable over Chase '106. Claims 14, 16, and 17 each depend from claim 7, which is patentable over Chase '106 for the reasons stated above. Thus claims 14, 16, and 17 are likewise patentable.

In summary, the rejection of claims 12, 14, 16, and 17 under 35 USC § 103(a) as being unpatentable over Chase '106 and in the case of claim 12, in view of Nygard '938, has been overcome and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

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Allowance of claims 7 to 20, as amended, at an early date is solicited.

Respectfully submitted,

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Date

By: Yen Tong Florczak  
Yen Tong Florczak, Reg. No.: 45,163  
Telephone No.: 651-737-0710

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833